

claims 1-3 and 10-16 are pending. Applicants request reconsideration of the pending claims in view of the following remarks.

## **II. Oath/Declaration**

The Examiner objected to the oath and declaration as being defective because it failed to identify the parent application of which the benefit is claimed under 35 U.S.C. §120. Applicants will file, under separate cover, a new oath and declaration identifying the parent application from which benefit is claimed.

## **III. Drawing Objections**

The Examiner objected to the drawings because they included a reference sign not mentioned in the description. Accordingly, Applicants have removed the reference character 65 (Fig. 3A) that was not mentioned in the description. Applicants submit new formal drawings (Figures 1-24) to overcome the Examiner's objection. Further, Applicants submit a marked-up version of FIG. 3A showing the reference character (65) to be removed therefrom in red ink.

## **IV. Amendments to the Specification**

Applicants have amended the specification, as requested by the Examiner, to correct typographical errors and to comply with the Examiner's request. No new matter has been added.

## **V. Claim Objections**

Claim 1 has been amended to correct the informalities noted by the Examiner. Applicants contend that the amendments to claim 1 are made only to correct the informalities noted by the Examiner, and are not intended to limit the scope of the claimed invention.

## **VI. Claim Rejections – 35 USC § 103**

A. Claims 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ryan et al. (U.S. Patent 5,285,795) in view of Underwood et al. (U.S. Patent 6,461,350). For at least the following reasons, Applicants respectfully traverse the rejection.




MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: "To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding claim 1 as filed, the Examiner has failed to establish prima facie obviousness of the claimed invention, because the cited references fail to teach or suggest all of the claim limitations recited therein. More particularly, Ryan, either alone or in combination with Underwood, fails to teach or suggest a tissue cutting device that includes: (1) a cannula hub mounted to an elongated handpiece; (2) a cannula hub that includes a fluid port; (3) a tube connected at one end to the fluid port of the cannula hub and having an opposite end connectable to a fluid source; or (4) an outer cannula supported at a proximal end of the cannula hub, as recited in claim 1 as filed. Rather, Ryan discloses a percutaneous discectomy system 20 having a probe body 26. The probe body 26 in Ryan does not include any "hub," let alone a hub that is mounted to the probe body 26. Instead of employing a cannula hub to support the outer cannula, Ryan teaches supporting the needle housing 52 with the probe body 26. Moreover, Underwood fails to make up for the deficiencies of Ryan.

B. Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ryan et al. (U.S. Patent 5,285,795) in view of Underwood et al (U.S. Patent 6,461,350) as applied to claim 1 above, and further in view of Reimels (U.S. Patent No. 5,580,347). For at least the following reasons, Applicants respectfully traverse the rejection.

The argument made above with respect to claim 1 is also applicable here. Ryan, either alone or in combination with Underwood, fails to teach or suggest a tissue cutting device that includes: (1) a cannula hub mounted to an elongated handpiece; (2) a cannula hub that includes a fluid port; (3) a tube connected at one end to the fluid port of the cannula hub and having an



opposite end connectable to a fluid source; or (4) an outer cannula supported at a proximal end of the cannula hub, as recited in claim 1 as filed.

For at least these reasons, the Examiner has failed to make out a prime facie case of obviousness under §103(a), and the rejection should be withdrawn.


### CONCLUSION

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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Respectfully submitted,

By   
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